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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,125	10/12/2001	Carol Stonebrook Lachance	LD30/01	2412

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EXAMINER

FLANAGAN, BEVERLY MEINDL

ART UNIT PAPER NUMBER

3739

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,125

Applicant(s)

LACHANCE, CAROL
STONEBROOK

Examiner

Beverly M. Flanagan

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Beverly M. Flanagan
BEVERLY M. FLANAGAN
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Reopen Prosecution/Withdrawal of Finality of Office Action

In view of newly discovered prior art, PROSECUTION OF THIS APPLICATION IS HEREBY REOPENED. Accordingly, the finality of the Office action of Paper No. 7 (mailed June 3, 2003) is hereby **withdrawn**.

The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 5-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (U.S. Patent No. 5,507,794) in view of Douglas (U.S. Patent No. Des. 405,187).

In regard to claims 2 and 5, Allen teaches a gel pack 40 that can be cooled to 32 to 0 degrees Celcius having a gelatinous medium 44 therein and an envelope 44 comprised of a flexible plastic film (see Figure 5 and col. 4, lines 9-16). Allen teaches that the gel pack 40 may be heated or cooled by conventional means, such as a refrigerator (see col. 4, lines 17-25). Allen also teaches a pouch 20 for holding the gel pack 40 comprised of a soft material, such as terry cloth or brushed cotton (see col. 3,

lines 61-65). Each pouch 20 includes an enclosure 22 and an opening 24 communicating with the enclosure, where the opening 24 is dimensioned and configured to allow the gel pack 40 to be inserted through the opening 24 and positioned in the enclosure 22 (see col. 4, lines 1-5). Figure 1 shows that the pouch 20 and enclosure 22 are stitched or otherwise fastened over the lower two-thirds with the upper one-third forming the opening 24, so that the gel pack 40 is properly retained within the pouch 20 and enclosure 22. Allen is silent as to the gel pack 40 being disc-shaped or circular and decorative indicia on the enclosure 22. However, Douglas discloses a similar hot/cold therapy sports pack that is disc-shaped or circular and has decorative indicia on one side of the enclosure. Douglas thus demonstrates that hot/cold packs shaped in disc or circular forms and having decorative indicia are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to fabricate the gel pack 40 of Allen in the disc or circular shape with decorative indicia on one side, as disclosed by Douglas. **In regard to claim 6,** Allen teaches that the pouch 20 is preferably composed of a soft material, such as terry cloth or brushed cotton, and that other materials, such as Lycra, nylon and poly-wool blends can be used (see col. 3, lines 61-65). As Pellon is a cloth material and since Allen teaches the use of other suitable materials, it would have been obvious for one of ordinary skill in the art to utilize Pellon as the material for the pouch 20. **In regard to claims 7-13,** Douglas shows a variety of decorative indicia, including a tennis ball and a baseball (see Figures 1-20). Application of other decorative indicia, such as a teddy

bear, a volley ball, a hockey stick, a flower and a lady bug would have been obvious to one of ordinary skill in the art as obvious design choices.

Claims 1, 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen (U.S. Patent No. 5,507,794) in view of Douglas (U.S. Patent No. Des. 405,187) and further in view of Thomas et al. (U.S. Patent No. 5,215,080).

In regard to claim 1, Allen teaches a gel pack 40 that can be cooled to 32 to 0 degrees Celcius having a gelatinous mediumn 44 therein and an envelops 44 comprised of a flexible plastic film (see Figure 5 and col. 4, lines 9-16). Allen teaches that the gel pack 40 may be heated or cooled by conventional means, such as a refrigerator (see col. 4, lines 17-25). Allen also teaches a pouch 20 for holding the gel pack 40 comprised of a soft material, such as terry cloth or brushed cotton (see col. 3, lines 61-65). Each pouch 20 includes an enclosure 22 and an opening 24 communicating with the enclosure, where the opening 24 is dimensioned and configured to allow the gel pack 40 to be inserted through the opening 24 an positioned in the enclosure 22 (see col. 4, lines 1-5). Figure 1 shows that the pouch 20 an enclosure 22 are stitched or otherwise fastened over the lower two-thirds with the upper one-third forming the opening 24, so that the gel pack 40 is properly retained within the pouch 20 and enclosure 22. Allen is silent as to the gel pack 40 being disc-shaped or circular and decorative indicia on the enclosure 22. However, Douglas discloses a similar hot/cold therapy sports pack that is disc-shaped or circular and has decorative indicia on one side of the enclosure. Douglas thus demonstrates that hot/cold packs

shaped in disc or circular forms and having decorative indicia are well known in the art. Accordingly, it would have been obvious for one of ordinary skill in the art at the time the invention was made to fabricate the gel pack 40 of Allen in the disc or circular shape with decorative indicia on one side, as disclosed by Douglas. Allen also teaches a support member 10 for carrying the pouches and applying them to a user. Thomas et al. teach a therapeutic cold pack system including a carrying case for carrying ice packs made of heavy cloth material with front and back walls where the back wall extends into a flap for closing the case. Also, stitching and hook and loop fastening strips form two pockets in the case for holding two ice packs. It would have been obvious to one of ordinary skill in the art at the time of invention to use a carrying case as in Thomas et al. with the device of Allen to provide a suitable means for transporting the device and attaching the device to a user. Further, it would have been obvious to one of ordinary skill in the art at the time of invention that the use of a tie to close the carrying case as in the claims represents an upatentable design choice over the hook and loop strips in the combined device of Allen and Thomas et al. that would not change the functionality of the device. **In regard to claim 3**, Allen teaches all of the limitations of this claim as described above except for the carrying case. Thomas et al. teach a therapeutic cold pack system including a carrying case for carrying ice packs made of a heavy cloth material with front and back walls where the back wall extends into a flap for closing the case. Also, stitching and hook and loop fastening strips form two pockets in the case for holding two ice packs. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a carrying case as in Thomas et al. with the device of

Allen to provide a suitable means for transporting the device and attaching the device to a user. **In regard to claim 4**, Allen and Thomas et al. teach all of the limitations of this claim as described above except for the tie for closing the device. It would have been obvious to one of ordinary skill in the art at the time of invention that the use of a tie to close the carrying case as in the claims represents an unpatentable design choice over the hook and loop strips in the combined device of Allen and Thomas et al. that would not change the functionality of the device.

Response to Arguments

Applicant's arguments filed November 24, 2003 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., gravity holding the jacket to the body without the use of any other support means) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, in response to applicant's argument that the devices of Allen and Thomas et al. include support members to hold the cooling patches or packs in place whereas the instant invention used gravity, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art

structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

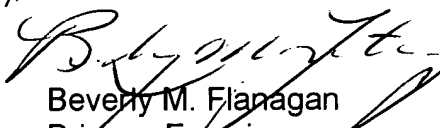
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should note the following prior art references disclosing disc or circular shaped cooling packs: DeLuisa et al., U.S. Patent No. 6,623,517 and Dyken et al., U.S. Patent No. 6,093,202.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beverly M. Flanagan whose telephone number is (703) 305-7202. The examiner can normally be reached on Mondays, Tuesdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Beverly M. Flanagan
Primary Examiner
Art Unit 3739
